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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re County Bank

Serial No. 78/033,833

Kent Brian Bathurst of Dowling Aaron & Keeler for County Bank.

Tarah K. Hardy Ludlow, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Cissel, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

County Bank seeks registration on the Principal Register
for the mark COUNTYBANK.COM for services recited as "banking
services via the Internet," in International Class 36.¹

This case is now before the Board on appeal from the
final refusal to register based upon Section 2(d) of the
Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining
Attorney has held that applicant's mark, if it is used in
connection with the recited services, so resembles the mark
THE COUNTY BANK, which is registered for "banking services,"

¹ Application Serial No. 78/033,833 was filed on November 3, 2000
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce.

also in International Class 36,² that it would be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed this appeal, but applicant did not request an oral hearing.

We affirm the refusal to register.

Applicant contends that applicant's online banking services can be differentiated from registrant's banking services; that the two marks are different in sound, meaning and connotation; and that a review of the federal register shows that the cited mark is weak as applied to banking services.

By contrast, the Trademark Examining Attorney takes the position that applicant's services are closely related to registrant's services; that the respective marks are confusingly similar; and that applicant has failed to demonstrate the weakness of marks such as registrant's in the field of banking services.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ

² Registration No. 2,156,602, issued on the Principal Register on May 12, 1998.

563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to a consideration of the respective services, it is well settled that services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Despite applicant's arguments that these respective services are easily differentiated, we concur with the position of the Trademark Examining Attorney that applicant's "banking services via the Internet" and registrant's services recited as merely "banking services" are so closely related in a commercial sense that, if rendered under similar marks, confusion as to their origin or affiliation would be likely.

In defining registrant's and applicant's respective customers, we note that both applicant and registrant provide, or will provide, retail banking services to the consumer market. As to the way in which these services are, or will be, offered, it is explicit in applicant's recitation that its services are to be provided online. While registrant's recitation of services is not similarly explicit, there is certainly no restriction in the registration that precludes registrant from offering its services online. In short, we must consider the services set forth in the application as being encompassed within the services recited in the registration. In any case, even if registrant's services were limited to a bricks-and-mortar operation, this distinction is without any meaningful significance because consumers in search of banking services could still obtain essentially the same services through either applicant's online services or registrant's more traditional locations. Consider the consumer who historically had only utilized registrant's banking services through her local, full-service branch bank. That same consumer, when opting to access her banking services in cyberspace, could well choose applicant's online banking services under the mistaken belief that it is the same company that provides her traditional banking services.

We turn then to the respective marks. We find that the first portion of applicant's mark (COUNTYBANK) is virtually identical to the registered mark in terms of appearance, pronunciation and connotation. The absence of the word "The" in applicant's mark does very little to distinguish applicant's mark from the registered mark in terms of appearance, pronunciation or connotation. The absence of a space between the words "County" and "Bank" in applicant's mark is insignificant in the context of a domain name, where spaces are not permitted. The only other real point of difference between the two marks is that applicant's mark ends with ".COM." However, there is no serious dispute but that the designation ".COM" refers to commercial sites on the Internet. Thus, in relation to applicant's online banking services, the ".COM" portion of applicant's mark is highly descriptive in that it readily informs consumers that applicant's banking services are, indeed, available online. Accordingly, this portion of the mark has little source-identifying significance.

Based upon the similarities in sound, meaning and connotation, we find that these two marks are quite similar as to overall commercial impressions. A consumer familiar with registrant's mark THE COUNTY BANK for banking services, upon seeing applicant's mark COUNTYBANK.COM for online banking

services, would easily assume that registrant has now expanded its banking services to offer said services online.

Accordingly, we find that the contemporaneous use of applicant's mark COUNTYBANK.COM for its online banking services would be likely to create confusion with the registered mark THE COUNTY BANK for banking services.

Finally, applicant argues that the registered mark is weak given third-party registrations of marks that contain variations on COUNTY BANK. However, the only one applicant specifically mentions is a relatively new registration for FIRST COUNTY BANK.

In order to counter this argument, the Trademark Examining Attorney produced a list of twenty registrations owned by financial institutions where the marks incorporate within these composites the terms COUNTY and BANK, noting that nineteen of these registrations (i.e., all but the cited registration) contain other distinguishing wording.³

³ Because the file does not appear to contain copies of these twenty registrations, we note in passing that the Board does not take judicial notice of third-party registrations. The mere citation to such purported registrations "is insufficient to make them of record." *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). The proper procedure, instead, for making information concerning third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the PTO's own computerized database. See *In re Consolidated Cigar Corp.*, 35 USPQ2d 1290, 1292 n. 3 (TTAB 1995); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); and *In re Melville Corp.*, 18 USPQ2d 1386, 1388 n. 2 (TTAB 1991).

These registrations are not of record, so we have not considered them in reaching our decision. However, even if we had considered them, except for the cited registration, all of the other registered marks contain further modifiers.

In fact, most of these composite marks contain references to particular county names. Hence, given the wide variety of quite disparate county names appearing on this listing, when each of these marks containing a named county is viewed in its entirety, each one creates a unique commercial impression.

Furthermore, as to the listed composite marks without any specific county names, we note that courts have held that because consumers tend to exercise a relatively high degree of care in selecting financial services, prospective customers are more likely to notice what, in other retail contexts, may be relatively minor differences in marks. For example, some courts have determined there is no likelihood of confusion even where the names of financial institutions share the same dominant terms. See First Savings Bank, F.S.B. v. First Bank System, Inc., 101 F.3d 645, 40 USPQ2d 1865 (10th Cir. 1996) [no likelihood of confusion between "FirstBank" and "First Bank System" service marks where bank logos were visually distinct]; and Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan, 651 F.2d 311, 211 USPQ 844 (5th Cir. 1981) [no likelihood of confusion between "Sun Federal Savings" and "SunBanks"]

service marks]. In this vein, registered marks such as THE COUNTY BANK, FIRST COUNTY BANK, COUNTY SAVINGS BANK and COUNTY NATIONAL BANK arguably contain relatively minor differences that permit them to coexist.

By contrast, when comparing COUNTYBANK.COM with THE COUNTY BANK, there are not even any minor differences to tip off the most careful of consumers to a difference in source. Rather, bank customers are likely to assume that when THE COUNTY BANK goes online, its domain name would be COUNTYBANK.COM. Hence, given the analysis above, we cannot agree with applicant that the mere presence ".com" provides the requisite dissimilarity from the cited mark.

Decision: The refusal to register pursuant to Section 2(d) of the Trademark Act is hereby affirmed.